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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,724	05/02/2006	Jakob Socher	0600-1059	3160
466 7590 06/24/2010 YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314				
EXAMINER WOOD, ELLEN S				
ART UNIT		PAPER NUMBER		
1782				
NOTIFICATION DATE		DELIVERY MODE		
06/24/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

### Office Action Summary

**Application No.**

10/577,724

**Applicant(s)**

SOCHER, JAKOB

**Examiner**

ELLEN S. WOOD

**Art Unit**

1782

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13-22 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-16 and 24-26 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/07/2010 has been entered.
2. Applicant's arguments, filed 05/07/2010, with respect to claims 13-15 and 24-26 have been fully considered and are persuasive. The rejection of claims 13-16 and 24 as being rejected under 35 U.S.C. 102(b) as being anticipated by Virog et al. (US 4,046,275, hereinafter "Virog") has been withdrawn.

### ***Claim Objections***

3. Claim 15 is objected to because of the following informalities: Claim 15 states "the band as claimed in ether claim 13". The "either" in the claim should be removed. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13-16 and 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. The recitation of "substantially" fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "substantially" is subjective and can be read in various context depending on the reader. Thus, the claims are indefinite.
7. The recitation that an element is "configured to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. Thus, the applicant fails to particularly point out and distinctly claims what "configured to" defines within the claims.

#### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 13-15 and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Weder (US 2004/0237399).

In regards to claim 13, Weder discloses a wrapper for wrapping a flower pot and/or floral grouping or other item [abstract]. The wrapper is constructed of a sheet of material having a central decorative portion and a peripheral decoration [abstract]. The decorative wrapper can be used for fruit or candy boxes, and other boxed or unboxed items including nuts, vegetables, plant bulbs, and comestibles [0037]. Thus, a decorative band for packaging purposes.

Fig. 7 discloses a wrapper that is constructed of a sheet material [0060-0061], thus a thin film. The wrapper has two opposite free ends 24d and 26d [0060-0061 and fig. 7]. The sheet material extends longitudinally from a first of the two free ends to a second of the two free ends to form a first longitudinal edge, 40d, and a second longitudinal edge, 20d [0060-0061 and fig. 7].

The sheet material has at least one first portion, having a maximum width L1 [fig. 7]. In regards to Fig. 7, L1 is considered the width between 20d and 22d.

The sheet material has at least one second portion having a minimum width L2, the minimum width L2 being between one third and two thirds of the maximum width L1 [fig. 7 and 0063]. L2 is considered the width between 42d and 40d.

The sheet material is configured to completely surround said periphery of said lateral annular wall of said food packaging [fig. 8 and 0037].

The first longitudinal edge, from the first of the two free ends to the second of the two free ends, is rectilinear and substantially parallel to a longitudinal axis of the band [fig. 7 and 0060-0061].

In regards to claim 14, Weder discloses that the second longitudinal edge has a convex profile along the first portion, 20d, and concave profile along the second portion, 22d, the convex profile being complementary to the concave profile [fig. 7].

In regards to claim 15, Weder discloses that the second longitudinal edge has a profile of an undulating line [fig. 7].

In regards to claim 24, Weder discloses that the undulating line is comprised of a plurality of alternating curves [fig. 7].

In regards to claims 25-26, Weder discloses that the free ends are configured to either overlap or abut one another in a completely surrounding said periphery of said lateral annular wall of said food packaging [0061 and fig. 8].

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weder (US 2004/0237399).

In regards to claim 16, Weder discloses a decorative wrap for completely surrounding a periphery of a food packaging material as previously discussed.

Weder is silent with regards to the maximum width L1 is substantially equal to a maximum height H of the lateral wall of the food packaging.

Weder discloses that the decorative wrapper can be designed for non-plant items such as baskets, gifts, gift boxes, fruit or candy boxes and other boxed or unboxed items including nuts, vegetable, plant bulbs and comestibles [0037]. It would be obvious to one of ordinary skill in the art at the time of the invention to substitute the maximum width L1 to be substantially equal to a maximum height of the lateral wall of the food packaging motivated by the expectation as to form a decorative wrapper that can be formed on various types of packages.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1-16 and 24-26 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELLEN S. WOOD whose telephone number is (571)270-3450. The examiner can normally be reached on M-F 730-5 with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ELLEN S WOOD/  
Examiner, Art Unit 1782

/Rena L. Dye/  
Supervisory Patent Examiner, Art Unit 1782